



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,723	06/22/2006	Juergen Paul	810357	9921
95683 7590 07/18/2011 Leydig, Voit & Mayer, Ltd. (Frankfurt office) Two Prudential Plaza, Suite 4900 180 North Stetson Avenue Chicago, IL 60601-6731				
			EXAMINER RAO, ANAND SHASHIKANT	
			ART UNIT 2486	PAPER NUMBER
			NOTIFICATION DATE 07/18/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chgpatent1@leydig.com

Office Action Summary

Application No.

10/596,723

Applicant(s)

PAUL ET AL.

Examiner

ANDY RAO

Art Unit

2486

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/31/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Application Status

1. The following is a first office action upon examination of application number 10/596,723. Claims 59-92 are pending in this application and have been examined on the merits discussed below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 42 shown in Figure

1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "21" has been used to designate both first motor and a part of the stand both in Figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 7 & 72. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 59-85 & 88-92 rejected under 35 U.S.C. 102(b) as being anticipated by Bacus (2002/0135678).

Regarding claim 59, Bacus teaches a microscope system comprising: a microscope including an automatically adjustable subassembly having an adjustable element; a digital camera configured to acquire image data of an image of a specimen; and a computer system including a display and a storage unit configured to store the image data and to store, associated with the image data, data defining a setting of the automatically adjustable subassembly corresponding to the image data (Fig. 9A & 9B), as in the claim.

Regarding claim 60, Bacus teaches the microscope system as recited in claim 59 wherein the storage unit is configured to store image data of a reference image and to store, associated with the image data of the reference image, data defining a setting of the automatically adjustable subassembly corresponding to the image data of the reference image (Table 3), as specified.

Regarding claim 61, Bacus teaches the microscope system as recited in claim 59 wherein the automatically adjustable subassembly includes at least one of an objective nosepiece, a microscope stage, a condenser, a magnification changer, a filter changer, an adjustable diaphragm, a brightness controller of a lighting device, and a setting element of the digital camera (Fig. 9B), as specified.

Regarding claim 62, Bacus teaches the microscope system as recited in claim 61 wherein the objective nosepiece is configured to receive a plurality of objectives each in a respective position and to rotate between the positions, and further comprising a motor associated with the

objective nosepiece and configured to rotate the objective nosepiece between the positions (Fig. 9B; Par. [0087]), as specified.

Regarding claim 63, Bacus teaches the microscope system as recited in claim 61 further comprising a first, a second and a third motor associated with the microscope stage, the first motor being configured to move the microscope stage in an X-direction, the second motor being configured to move the microscope stage in a Y-direction and the third motor being configured to move the microscope stage in a Z-direction (Fig. 9B), as specified.

Regarding claim 64, Bacus teaches the microscope system as recited in claim 61 further comprising a motor-driven actuation element configured to change over the condenser (Par. [0086], lines 17-20), as specified.

Regarding claim 65, Bacus teaches the microscope system as recited in claim 61 further comprising a motor-driven actuation element configured to change over the magnification changer (Par. [0086], lines 9-12; Par. [0087]), as specified.

Regarding claim 66, Bacus teaches the microscope system as recited in claim 61 wherein the filter changer includes a filter wheel including a motor configured to move individual filter elements into an optical axis (Fig. 9B), as specified.

Regarding claim 67, Bacus teaches the microscope system as recited in claim 61 further comprising a motor configured to adjust the adjustable diaphragm (Fig. 9B; Par [0086], lines 14-17), as specified.

Regarding claim 68, Bacus teaches the microscope system as recited in claim 61 wherein the brightness controller includes an electronic circuit (Fig 9B; Par [0086], lines 4-7), as specified.

Regarding claim 69, Bacus teaches the microscope system as recited in claim 61 wherein the display is configured to depict a user interface of the digital camera configured to specify a setting of the digital camera (Fig. 2 & 3), as specified.

Regarding claim 70, Bacus teaches the microscope system as recited in claim 69 wherein the user interface of the digital camera includes a first area, a second area and a third area, settings for acquisition of the image can being specifiable in the first area, a configuration -for a type of the digital camera being settable in the second area, the image acquired by the digital camera being depictable in the third area (Fig. 2 & 10), as specified.

Regarding claim 71, Bacus teaches the microscope system as recited in claim 59 wherein the display is configured to depict a user interface for handling the image data stored in the storage unit and for handling settings of the microscope corresponding to the image data (Fig. 25), as specified.

Regarding claim 72, Bacus teaches the microscope system as recited in claim 71 wherein the user interface includes a plurality of windows (Fig. 2), as specified.

Regarding claim 73, Bacus teaches the microscope system as recited in claim 72 wherein the plurality of windows includes a first window configured to enter and display a type of the microscope (Fig. 13), as specified.

Regarding claim 74, Bacus teaches the microscope system as recited in claim 72 wherein the plurality of windows includes a second window configured to enter and display a freely definable description (Par. [0108]), as specified.

Regarding claim 75, Bacus teaches the microscope system as recited in claim 72 wherein the plurality of windows includes a third window configured to enter and display a setting of the microscope (Fig. 2 & 3), as specified.

Regarding claim 76, Bacus teaches the microscope system as recited in claim 75 wherein the third window is configured to display at least one of a name assigned to the stored image data, a file name, a magnification of the objective used to acquire the image, a use of a magnification changer, a size of the diaphragm opening, a brightness, a type of condenser, an illuminated field diaphragm, a filter cube employed, an objective designation, a tube magnification, an X-position of a stage of the microscope, a Y-position of the stage, a Z-position of the stage, a contrasting method employed, a phototube employed, an article number of the phototube employed, and a position of an objective nosepiece of the microscope (Table 3), as in the claim.

Regarding claim 77, Bacus teaches the microscope system as recited in claim 72 wherein the plurality of windows includes a fourth window configured to display a list of names assigned to individual images made up of acquired image data (Fig. 23), as specified.

Regarding claims 78-79, Bacus teaches the microscope system as recited in claim 72 wherein the plurality of windows includes a fifth window configured to display, in a matrix as thumbnails, respective images corresponding to image data stored in the storage unit (Fig. 78), as specified.

Regarding claim 80, Bacus teaches the microscope system as recited in claim 59 wherein the computer system is associated with an input unit including at least one of a mouse, a trackball, a keyboard, a touchscreen (Fig. 9A-9B; Par. [0083]), as specified.

Regarding claim 81, Bacus teaches the microscope system as recited in claim 59 wherein the display is configured to depict a user interface useable to output a message indicating a status of the setting of the subassembly and based on the data defining the setting (Fig. 2 & 3), as specified.

Regarding claim 82, Bacus teaches the microscope system as recited in claim 81 wherein the user interface is configured to depict subassemblies that go with a type of the microscope and that are to be adjusted, and wherein a first subassembly of the subassemblies that is automatically adjusted on the basis of the data defining the setting is associated with a second message indicating a change that has been made (Fig. 10 & 13), as specified.

Regarding claim 83, Bacus teaches the microscope system as recited in claim 81 wherein the user interface is configured to depict subassemblies that go with a type of the microscope and that are to be adjusted, and wherein a first subassembly of the subassemblies that cannot be automatically adjusted on the basis of the data defining the setting is associated with a second message indicating that a change has not been made for the first subassembly (Fig. 10 & 13), as specified.

Regarding claim 84, Bacus teaches the microscope system as recited in claim 83 wherein the first subassembly is configured to be adjusted manually by a user (Fig. 13), as specified.

Regarding claim 85, Bacus teaches the microscope system as recited in claim 81 wherein the user interface is configured to depict subassemblies that go with a type of the microscope and that are to be adjusted, and wherein a first subassembly of the subassemblies that is not implemented in the microscope is indicatable on the display by a second message (Fig. 13), as specified.

Regarding claim 88, Bacus teaches the microscope system as recited in claim 88 wherein microscope stage includes a slide holder, and wherein the specimen slide includes an interacting element configured to interact with a counterpart on the slide holder (Par. [0082], lines 8-14), as specified.

Regarding claim 89, Bacus teaches a method for operating a microscope system including a microscope having at least one automatically adjustable subassembly with at least one: adjustable element, a digital camera connected to the microscope, and a computer system having at least one display and at least one storage unit, the method comprising: acquiring, by the digital camera, image data of an image of a specimen; storing the image data in the storage unit; associating, with the image data stored in the storage unit, data defining a setting of the at least one subassembly of the microscope (Fig 9A & 9B); depicting the image on a user interface of the display; selecting the image depicted on the user interface and the associated data defining the setting of the at least one automatically adjustable subassembly of the microscope (Fig. 2 & 3); and automatically establishing the setting of the at least one automatically adjustable subassembly using the at least one adjustable element (Fig. 13), as in the claim.

Regarding claim 90, Bacus teaches the method as recited in claim 89 further comprising: storing, in the storage unit, image data of at least one reference image; and associating, with the at least one reference image, data useable for a setting of the at least one automatically adjustable subassembly corresponding to the image data of the at least one reference image (Par. [0008], lines 15-18), as specified.

Regarding claim 91, Bacus teaches the method as recited in claim 89 wherein the at least one automatically adjustable subassembly includes at least one of an objective nosepiece, a

microscope stage, a condenser, a magnification changer, a filter changer, an adjustable diaphragm, a brightness controller of a lighting device and a setting of the digital camera (Fig. 9B), as specified.

Regarding claim 92, Bacus teaches the method as recited in claim 89 wherein the display is configured to depict a user interface of the digital camera, the user interface including a first area, a second area and a third area, settings for acquisition of the image being specifiable in the first area, a configuration for a type of the digital camera being settable in the second area, the image acquired by the digital camera being depictable in the third area (Fig. 2 & 3), as specified.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 86-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacus in view of Johannsmeier (US Patent: 4,414,749).

Regarding claim 86, Bacus teaches the microscope system as recited in claim 59. However, Bacus fails to disclose details about the specimen slide and its markings as in the claim. Johannsmeier discloses wherein the microscope includes a stage and specimen slide receivable by the stage, the specimen slide including a marking detectable by the microscope system in order to provide the user with a reference point for an X-value and a Y-value of the stage (Johannsmeier: Col. 6, lines 37-42). Given these teachings it would have been obvious for

one of ordinary skill in the art at the invention to incorporate the teaching of Johannsmeier's reference markings fro slides into the Bacus teaching in order to confer the benefits of having Bacus' disclosure be able to quickly and efficiently organize the x and y references of the slides. The Bacus teaching, now incorporating Johannsmeier's slide reference markings has all of the features of the claim 86.

Regarding claim 87, the Bacus teaching, now incorporating Johannsmeier's slide reference markings has wherein the marking is disposed on a non-transparent part of the specimen slide (Johannsmeier: Col 6, lines 42-46), as in the claim.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDY RAO whose telephone number is (571)272-7337. The examiner can normally be reached on Monday-Friday 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

asr
/Andy S. Rao/
Primary Examiner, Art Unit 2486
July 12, 2011